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10/561,622	06/01/2006	Masaki Hashimoto	KIT-404	9658

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FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK, NY 10103-3198

EXAMINER	
NGUYEN, SON T	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/561,622
Filing Date: June 01, 2006
Appellant(s): HASHIMOTO ET AL.

Norman D. Hanson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/13/2010 appealing from the Office action mailed 12/15/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

claims 11-27 are rejected and pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Re32476	Kistner	8-1987

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11,15,16,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kistner (Re.32476).

For claim 11, Kistner teaches a plant cultivating substrate produced by reacting: a water-retentive filling material (col. 5,lines 20-27), water (col. 2,line 30), urethane prepolymer (col. 2,lines 37-50) and a polyol (col. 2,line 40,col. 3,lines 51-65) under conditions which form a plant cultivating substrate (col.5,lines 42-58).

For claim 15, Kistner teaches wherein said urethane prepolymer contains an isocyanate group (col. 2,lines 40-45,65-69).

For claim 16, Kistner teaches wherein said urethane prepolymer is formed by reacting toluene diisocyanate with a polyol (col. 4,lines 10-55).

For claim 19, Kistner teaches wherein said water- retentive filling material comprises: peat moss, coco peat, sawdust, coconut husk, chaff, chaff compost, bark compost, pearlite, vermiculite, or hydrophilic foam resin pulverized powder (col. 5,lines 20-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-14,17,18,20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kistner (as above).

For claim 12, Kistner teaches wt. % in col. 6,lines 25-3 and in his examples but is silent about an example being wherein said water retentive filling material under dry conditions is from 15 to 60 wt. % of said plant cultivating substrate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the water retentive filling material under dry conditions in the substrate of Kistner be from 15 to 60 wt. % of said plant cultivating substrate, depending on the type of plant grown in the substrate because each plant type required different ingredients in the substrate and depending on the potency of the substrate for the plant to grown therein.

For claim 13, Kistner teaches polyol but is silent about the polyol contains an ester group. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an ester group in the polyol of Kistner, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (more potent or not) as a matter of obvious choice.

For claim 14, Kistner teaches wt. parts for the polyol in col. 6,lines 27-30 and in his examples but is silent about wherein the polyol is present in an amount of from 0.1 to 300 weight parts relative to 100 weight parts of the water-retentive filling material under dry conditions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the polyol of Kistner be present in an amount of from 0.1 to 300 weight parts relative to 100 weight parts of the water-retentive filling material under dry conditions, depending on the type of plant grown in the substrate because each plant type required different ingredients in the substrate and depending on the potency of the substrate for the plant to grown therein.

For claim 17, Kistner teaches wt. parts for the urethane prepolymer in col. 6,lines 23-35 and in his examples but is silent about wherein said urethane prepolymer is present in an amount of from 50 to 300 weight parts relative to 100 weight parts of the water-retentive filling material under dry conditions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the urethane prepolymer of Kistner be present in an amount of from 50 to 300 weight parts, depending on the type of plant grown in the substrate because each plant type required

different ingredients in the substrate and depending on the potency of the substrate for the plant to grown therein.

For claim 18, Kistner teaches wt. parts for the urethane prepolymer in col. 6,lines 23-35 and in his examples but is silent wherein said urethane prepolymer is present in an amount of from 120 to 200 weight parts relative to 100 weight parts of the water-retentive filling material under dry conditions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the urethane prepolymer of Kistner be present in an amount of from 120 to 200 weight parts relative to 100 weight parts of the water-retentive filling material under dry conditions, depending on the type of plant grown in the substrate because each plant type required different ingredients in the substrate and depending on the potency of the substrate for the plant to grown therein.

For claim 20, Kistner is silent about wherein the substrate has water absorptivity of from 25% to 75% by weight relative to the weight of said plant cultivating substrate, hardness of from 20N to 40N, and restoring force of from 4N to 10N. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the substrate of Kistner with a water absorptivity of from 25% to 75% by weight relative to the weight of said plant cultivating substrate, hardness of from 20N to 40N, and restoring force of from 4N to 10N, depending on the type of plant grown in the substrate because each plant type required different ingredients in the substrate and depending on the potency of the substrate for the plant to grown therein.

For claim 21, Kistner teaches a method of manufacturing a plant cultivating substrate (col. 1,lines 38-47,col. 5,lines 42-58) comprising reacting and curing (col. 2, lines 28-36,col.3,lines 6-15,col.4,line 55,col. 5,lines 55-58) (i) a water-retentive filling material (col. 5,lines 20-26), (ii) water (col. 2,line 30), (iii) a urethane prepolymer (col. 2,lines 37-50) and (iv) a polyol (col. 2,line 40,col. 3,lines 51-65). Kistner teaches wt. % in his examples but is silent wherein said water-retentive filling material under dry conditions is from 15 to 60 wt.. % of said plant cultivating substrate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the water-retentive filling material of Kistner under dry conditions be from 15 to 60 wt. % of said plant cultivating substrate, depending on the type of plant grown in the substrate because each plant type required different ingredients in the substrate and depending on the potency of the substrate for the plant to grown therein.

For claim 22, Kistner teaches mixing the ingredients depends on the intended use of the substrate (col. 5,lines 28-40,52-68,col. 6,lines 1-13), thus, Kistner does not specifically states (i) mixing the water-retentive filling material with said water to form a first suspension, (ii) adding said urethane prepolymer and said polyol to said first suspension and mixing to form a second suspension, (iii) reacting and curing said second suspension to obtain the plant cultivating substrate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the steps of (i) mixing the water-retentive filling material with said water to form a first suspension, (ii) adding said urethane prepolymer and said polyol to said first suspension and mixing to form a second suspension, (iii) reacting and curing said

second suspension to obtain the plant cultivating substrate in the method of Kistner, depending on the user's intended use of the substrate as stated by Kistner.

For claim 23, Kistner teaches wt. parts for the polyol in col. 6,lines 27-30 and in his examples but is silent about wherein the polyol is present in an amount of from 0.1 to 300 weight parts relative to 100 weight parts of the water-retentive filling material under dry conditions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the polyol in the method of Kistner be present in an amount of from 0.1 to 300 weight parts relative to 100 weight parts of the water-retentive filling material under dry conditions, depending on the type of plant grown in the substrate because each plant type required different ingredients in the substrate and depending on the potency of the substrate for the plant to grown therein.

For claim 24. Kistner teaches polyol but is silent about the polyol contains an ester group. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an ester group in the polyol of the method of Kistner, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (more potent or not) as a matter of obvious choice.

For claim 25, Kistner teaches wherein said reacting and curing takes place in a substrate forming mold having a top and a bottom (col. 5,lines 42-58).

For claim 26, Kistner is silent about wherein said manufacturing is effected such that an upper face of the plant cultivating substrate is located on the bottom of said substrate forming mold. It would have been obvious to one having ordinary skill in the

art at the time the invention was made to manufacture the substrate of Kistner such that an upper face of the plant cultivating substrate is located on the bottom of said substrate forming mold, depending on the user's preference to employ such known molding process or another known molding process.

For claim 27, Kistner teaches wherein said water-retentive filling material comprises: peat moss, coco peat, sawdust, coconut husk, chaff, chaff compost, bark compost, pearlite, vermiculite, or hydrophilic foam resin pulverized powder (col. 5,lines 20-26).

(10) Response to Argument

Appellant argued that Kistner does not teach polyol because Example 1 of Kistner describes the reaction of polyoxyethylene diol with tolylene diisocyanate, to produce a urethane prepolymer. Then, at Example 2, the prepolymer, without polyol, is added to sand and water.

Examples 1-2 of Kistner show that the urethane prepolymer is a separate element from the polyol because it does not have to include the polyol in order to classify it as urethane prepolymer. However, as explained in columns 3-4, polyol can be added with polyoxyethylene diol and tolylene diisocyanate or other prepolymers (ingredients that, alone, can make up the urethane prepolymer); thus, this demonstrate that urethane prepolymer and the polyol are separate elements. For example, polyoxyethylene diol and tolylene diisocyanate or other prepolymers, alone, can be called urethane prepolymer, thus, polyol is not a part of urethane prepolymer. When one wishes to add polyol, even though it create one "integral" urethane prepolymer, polyol

can still be considered as a separate element, which does meet the claim language of “urethane prepolymer and polyol”. In addition, examples 1-2 are merely two examples of the invention that the user can have for the substrate but not necessary or the invention as a whole.

Appellant argued that claim 21 calls for "reacting and curing" four separate items. Such is not taught or suggested by Kistner.

In addition to the response above, col. 2, lines 30-45 of Kistner teaches the reacting and curing steps.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Son T. Nguyen/
Primary Examiner, Art Unit 3643

Conferees:

Timothy D Collins /TDC/

Andrea M Valenti /AMV/